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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Salvatore Lo Presti

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3504

466

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12/03/2008

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EXAMINER

MESH, GENNADIY

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

12/03/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/527,325	Applicant(s) LO PRESTI ET AL.	
	Examiner GENNADIY MESH	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's Amendment filed on October 28, 2008 is acknowledged.
Claims 14-20 are active. No amendments to claims were present.
Rejection is maintained as it was set forth in previous office action mailed on April 14, 2008.
2. The Declaration under 37 CFR 1.132 filed October 28, 2008 is insufficient to overcome the rejection of claims 14- 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement and under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement as set forth in the last Office action because presented facts (and arguments) are not germane to the rejection at issue.

Note, that basis for rejection of Claims 14 - 20 under 35 U.S.C. 112, first paragraph, was failing to comply with the enablement requirement, specifically that **undue experimentation** would be involved in determining how to practice and use applicant's invention, because specification does not reasonably provide enablement for limitation of Claim 14 as " applying at the same time a vibratory and rotational movement ".

The Declaration fails to provide any facts or argument why one of ordinary skill would be able to practice Applicant's invention without **undue experimentation**. Instead, the Declaration focuses on providing specific details of Applicant's invention, which has not been adequately described in original Specification.

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Applicant wrote: " In reviewing the Official Action, there is no apparent appreciation for the claimed method. In particular, there is no appreciation for the combined vibratory movement and rotational mechanical movement, which forms aggregates capable of withstanding heavy loads without further treatment, and under increasing pressure the granules have increasing compressive strength".

Note, that properties of aggregates, including ability to withstand heavy loads and have increasing compressive strength under increasing pressure" are not part of claimed subject matter claimed by Claims 14-20.

For this reason the Declaration also is not commensurate with scope of the claims 14-20.

Claim Rejections - 35 USC § 112

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 14- 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

Rejection is adequately set forth in paragraph 1 of the action mailed April 14, 2008 and incorporated herein by reference.

4. Claims 14 -20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Rejection is adequately set forth in paragraph 2 of the action mailed April 14, 2008 and incorporated herein by reference.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 14-15, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrow (WO 01/55051) in view of Horne (WO 02/36318) combine with evidence given by "Polyesters, Thermoplastic" Article published by Encyclopedia of Polymer Science, 2002.

Rejection is adequately set forth in paragraph 3 of the action mailed April 14, 2008 and incorporated herein by reference.

6. Claims 16,18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrow (WO 01/55051) in view of Horne (WO 02/36318) combine with evidence given by "Polyesters, Thermoplastic" as it was applied to claims 14-15, 17 and 19 above and in further view of Fong (US 6,368,682).

Rejection is adequately set forth in paragraph 4 of the action mailed April 14, 2008 and incorporated herein by reference.

Response to Arguments

7. Applicant's arguments filed October 14, 2008 and October 28, 2008 have been fully considered but they are not persuasive.

7.1. Applicant's Arguments related to Claims 14- 20 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement and under 35 U.S.C. 112, first paragraph, as failing to comply with the written

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description requirement based on alleged sufficiency of the Declaration filed on October 28, 2008 to overcome cited rejections.

As it was shown above (see paragraph 2 of this action) Declaration was found insufficient to overcome rejections under 35 U.S.C. 112, first paragraph and second paragraph.

Applicant's also stated (see page 2 of Arguments filed on October 14, 2008) that:" The necessary apparatus and equipment are already available and anyone skilled in the art may carry out the process without undue burden on the basis of the known technology ".

Note, that Applicant did not provide any evidence to support this statement and at the same time, Applicant admits that process is based on "**known technology**".

Therefore, Applicant's arguments related to Claims 14-20 rejected under 35 U.S.C. 112, first paragraph and second paragraph are not persuasive.

7.2. Applicant's Arguments related to Claims 14-15, 17 and 19 rejected under 35 U.S.C. 103(a) as being unpatentable over Barrow (WO 01/55051) in view of Horne (WO 02/36318) combine with evidence given by "Polyesters, Thermoplastic" and Claims 16,18 and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Barrow (WO 01/55051) in view of Horne (WO 02/36318) combine with evidence given by "Polyesters, Thermoplastic" as it was applied to claims 14-15, 17 and 19 above and in further view of Fong (US 6,368,682) based on following statement: "There is no suggestion in any of these applied documents that the simultaneously combined vibratory movement,

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caused by the oscillation of the beaker, and rotational mechanical movement, induced by the rapid rotation of a fine needle that spirals within the entire mass of the shrunken elements , causes the welding of the double-curvature vault shape elements to form hollow spheroidal shaped granules, which, when in the aggregate state, allows them to withstand heavy loads."

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies: **oscillation of the beaker, rapid rotation of a fine needle, welding of the double-curvature vault shape, hollow spheroidal shaped granules** are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, all Applicant's argument were found unpersuasive.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

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the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GENNADIY MESH whose telephone number is (571)272-2901. The examiner can normally be reached on 10 a. m - 6 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272 1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gennadiy Mesh
Examiner
Art Unit 1796

/GM/
/Vasu Jagannathan/
Supervisory Patent Examiner, Art Unit 1796

